REMARKS

Claims 1-39 are all the claims presently pending in the application. Support for the definition of the cost estimate added to claims 4 and 31 is found at lines 4-8 of page 17.

It is noted that Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 25 and 26 still stand rejected under 35 U.S.C. §101 as directed toward non-statutory subject matter, even though Applicants have reworded these two claims consistent with the Examiner's wording understood as appropriate address this rejection.

Claims 23, 25, 27, 29-32, 35, and 36 stand rejected under 35 U.S.C. § 102(e) as anticipated by US Patent 7,213,234 to Below et al.

Claims 1-22, 37, and 38 stand rejected under 35 U.S.C. §103(a) as unpatentable over Ramil et al., "Cost Estimation and Evolvability Monitoring for Software Evolution Processess", and claims 24, 26, 28, 33, and 34 stand rejected under 35 U.S.C. §103(a) as unpatentable over Below, further in view of Ramil.

Applicants again respectfully traverse these rejections, since there is no discussion in any of the cited references to categorize the sampling into N categories of complexity.

I. THE CLAIMED INVENTION

As exemplarily described in, for example, independent claim 1, the claimed invention is directed to a method of estimating a cost related to at least one of computer software development, computer software maintenance, and information technology services. A sample of computer code is read in accordance with a sampling technique and at least one sampling is categorized. A cost for a larger subset of the computer code from the sampling is calculated. At least one of the reading, the sampling, and the calculating is executed on a computer.

As explained beginning at line 4 on page 3 of the specification, estimating costs for modifications to existing software, such as porting, as well as other activities related to existing software such as maintenance, application portfolio management, and legacy transformation of software, typically requires a comprehensive investigation including scanning the entire set of code to look for potential problems. This comprehensive approach

can be very expensive and time consuming.

The claimed invention, on the other hand, teaches a novel method to estimate such costs by deriving a cost estimate using a sampling of the code.

II. THE STATUTORY SUBJECT MATTER REJECTION

The Examiner continues to reject claims 25 and 26 under 35 U.S.C. §101 as directed toward non-statutory subject matter, explained by the Examiner on page 33 of the Office Action as based on the holding in *In re Nuijten*.

In response, Applicants respectfully bring to the Examiner's attention that the facts of *Nuijten* are not present in the present application, since the present invention is not directed to a water marking and since the claimed invention is not directed to a "signal" *per se*.

That is, the rejected claim 14 of Nuijten's application read:

"*A signal with embedded supplemental data, the signal being encoded in accordance with a given encoding process ....* "

The claims of the present invention are not claiming a signal. Moreover, contrary to the Examiner's comments on page 33, the paragraphs in Applicants' specification cited by the Examiner are related to storage of computer instructions. A "signal" is clearly not suitable for storage of computer instructions, so that the Examiner's interpretation would not be consistent with either the original specification or engineering reality.

Therefore, Applicants respectfully request that the Examiner reconsider and formally withdraw this rejection, since a storage medium is statutory subject matter, whether the storage medium comprises a storage component on a computer, which is clearly statutory by reason of being a device and, thereby included in one of the four categories identified in 35 USC §101, or a standalone diskette of instructions, which is clearly statutory under the holding of *In re Beaurgard*, 53 F.3d, 1583 (Fed. Cir. 1995).

III. THE PRIOR ART REJECTIONS

The Examiner alleges that claims 23, 25, 27, 29-32, 35, and 36 are anticipated by Below, that claims 1-22, 37, and 38 are unpatentable over Ramil, and that claims 24, 26, 28, 33, and 34 are unpatentable over Below, further in view of Ramil.

Applicants again respectfully disagree, since there is no suggestion in any of these

cited references that teach or suggest categorization of the sampled source code into categories of complexity, let alone the calculation of an estimated cost based on categories of complexity, such as described in the equation defined in dependent claims 4 and 31.

The Rejections Based on Below

In the rejection currently of record, relative to the anticipation rejection based on Below, the Examiner merely repeats *verbatim* the wording of the previous rejection concerning categorization, again alleging in the rejection for claim 31 that the categorization of the source code in the present invention is analogous to the "stratified sampling" discussed in line 62 of column 3 through line 2 of column 4.

However, as Applicants pointed out in their previous response, "stratified sampling" is a term of art that is not equivalent to the categorization technique described in claim 31 (and incorporated into all independent claims, including those rejected as anticipated by Below), as evidenced that claim 7 specifically mentions this method and as described beginning at line 17 on page 21 of the present Application.

In contrast to reference to "stratified sampling" listed as the final method of claim 7, the language of claims 4 and 31 (and, now, all independent claims) clearly addresses the different method of categorizing based upon difficulty. This concept of "categorizing" is separately described in the present application, for example, at line 9 of page 15 through line 7 of page 16.

Therefore, given that the present application clearly distinguishes between these two concepts and even has separate claims directed to the two concepts, Applicants respectfully submit that the rejection of record for original claim 31 is improper as a matter of law, since the Examiner's interpretation of this claim terminology would be inconsistent with the meaning of the specification. As explained in MPEP §2111, the Examiner's broadest reasonable interpretation of claim terminology cannot be inconsistent with the meaning in an applicant's own specification.

Applicants further bring to the Examiner's attention that the latest rejection does not address this previous traversal by Applicants. Therefore, in accordance with MPEP §707.07(f), Applicants request that the Examiner provide an appropriate explanation in the next Office Action for this inconsistency of interpretation with terms of art, should this rejection be maintained.

Hence, turning to the clear language of the claims, in Below there is no teaching or

suggestion of: "... a graphic user interface to allow said computer code to be selected and categorized into categories of complexity....", as required by independent claim 23, and independent claims 25, 27, and 32 include similar wording.

Moreover, there is no suggestion in Below for the cost calculation defined by dependent claim 31.

Accordingly, Applicants respectfully submit that the rejection currently of record fails to reasonably demonstrate this element of the claimed invention for claims 23, 25, 27, 29-32, 35, and 36, and the Examiner is respectfully requested to reconsider and withdraw this anticipation rejection based on Below, as well as the obviousness rejection for claims 24, 26, 28, 33, and 34, since secondary reference Ramil does not overcome this fundamental deficiency of primary reference Below.

The Rejection Based on Ramil

The Examiner alleges that claims 1-22 and 37-39 are rendered obvious over Ramil, further in view of Below, since, according to the Examiner, secondary reference Below demonstrates categorization in lines 12-14 of column 3, lines 19-45 of column 4, and line 57 of column 5 through line 62 of column 6.

Applicants point out that the calculations in these cited locations in secondary reference Below are related to statistical calculations related to the sampling size, a concept entirely different from that of categorizing the source code of the sampling into different categories of difficulty.

Therefore, even if these two references were to be combined as urged, the combination would not provide the result described in even the independent claims.

Hence, turning to the clear language of the claims, in Ramil even if modified by Below, there is no teaching or suggestion of: "... categorizing at least one computer sampling", as required by independent claim 1. The remaining independent claims have similar language. Nor is there any suggestion in either reference of the cost calculation defined in dependent claim 4.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that at least some of claims 1-39 are patentably distinct over the prior art of record and are in condition for allowance and that other claims could be easily placed into condition for immediate allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: September 30, 2008

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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via EFS this Response under 37 CFR §1.116 to Examiner B. Wang on September 30, 2008.

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